

Remarks

The Specification is amended to add section headings as required by the Examiner. Claims 1-31 are pending in the present application with claims 1, 14, 17, 20, 29, and 31 in independent form. Claims 1, 9, 15, 20, 22, and 29-31 are currently amended.

The Specification is objected to for failing to include section headings. Claims 1-13, 15, and 20-28 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite. Claims 1-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0086079 to Kuo (hereinafter Kuo) in view of DE900544 to Koos (hereinafter Koos). Claims 1, 2, 5-8, 14-15, and 17 stand provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4-8, 10, and 12 of co-pending Application No. 11/578,082.

Rejection of Claims 1-13, 15, and 20-28 Under §112, Second Paragraph

Claims 1-13, 15, and 20-28 stand rejected under §112, second paragraph based on the use of “means of” in claims 1 and 20. The words “means of” are deleted from claims 1 and 20 and the Applicant respectfully asserts that this amendment overcomes the rejection under §112, second paragraph.

Rejection of Claims 1-31 under §103(a)

Claims 1-31 stand rejected under §103(a) as being unpatentable over to Kuo in view of Koos. The Applicant respectfully traverses the rejection of claims 1-31 under §103(a).

The Examiner states that Kuo fails to teach “enlarging the housing element to generate a low pressure in the housing space.” (page 5 of the Office Action). The Applicant agrees that Kuo fails to make such a teaching and respectfully asserts that Koos also fails to make such a teaching.

The Examiner states that it would be obvious “for one of ordinary skill in the art to modify Kuo with the sliding mechanism and rotary device as taught by DE 900544 for ensuring the molded article is pushed out of the flexible mold by providing a positive ejector mechanism...” (emphasis added). Notably, none of claims 1-31 of the present Application claim that the molded object is “pushed out” and none of claims 1-31 claim a “positive ejector mechanism.” In contrast, each of

independent claims 1, 14, 17, 20, 29, and 31 claim a moveable, dimensionally stable part of the housing element generating “a low pressure in said housing space...” The combination of Kuo and Koos fails to teach, or even suggest, this element. As the Examiner is aware, despite the revisions to MPEP §2100 largely in response to *KSR Int'l v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), a prior art combination must still teach or suggest all the claim limitations to establish a *prima facie* case of obviousness. The Board of Patent Appeals and Interferences has confirmed this principle after *KSR Int'l*. See *Ex parte Wada and Murphy*, Appeal 2007-3733. Because the combination of Kuo and Koos fails to teach, or even suggest, every element of independent claims 1, 14, 17, 20, 29, and 31, the Applicant respectfully asserts that claims 1, 14, 17, 20, 29, and 31 are non-obvious over Kuo and Koos.

The Examiner also states that “[t]he arrangement of the orifice in the side of the base can also be rearranged to the plunger portion 45 of DE 900544 for the same result of providing a negative pressure to the flexible mold.” (page 5 of the Office Action). The Applicant respectfully disagrees. Koos makes absolutely no teaching or suggestion that the slideable inner part 45 acts as a “plunger” that can provide a negative pressure. To the contrary, the slideable inner part 45 provides a positive force to the lipstick 114 to push the lipstick upwardly. As such, contrary to the Examiner’s assertion, Koos fails to teach or suggest a moveable, dimensionally stable part of the housing element generating “a low pressure in said housing space...” as claimed in independent claims 1, 14, 17, 20, 29, and 31. Again, because the combination of Kuo and Koos fails to teach, or even suggest, every element of independent claims 1, 14, 17, 20, 29, and 31, the Applicant respectfully asserts that claims 1, 14, 17, 20, 29, and 31 are non-obvious over Kuo and Koos.

Further, the Applicant respectfully notes that “moving a moveable, dimensionally stable part of said housing element to generate a low pressure in said housing,” as claimed in independent claims 1, 14, 17, 20, 29, and 31, is advantageous as set forth in the Background of the Invention and the Summary of the Invention sections of the present Application. Specifically, in Kuo, a space is required between the elastic mold 2 and the housing 1 so that the flexible mold 1 can expand under negative pressure. Because the elastic mold 2 is free, i.e., not supported on the sides, during the filling process, the mold can expand differently each time it is filled resulting variations in shape between different molded objects because the pressure of the filled-in material can expand itself at

different points to displace the elastic mold 2 at different places on each molding process. Further, the elastic mold 1 can become worn over time so that it does not provide the proper support for the filled-in material, which again leads to variation between different molded products. In the claimed invention, the moveable, dimensionally stable part of the housing element supports the elastic mold 2 during the molding to advantageously ensure consistent molded objects.

Further, aside from the fact that Koos makes no teaching or suggestion that the inner part 45 can act as a plunger that provides a negative pressure, by combining and rearranging the components of Kuo and Koos (see third paragraph on page 5 of the Office Action), the Examiner substantially reconstructs and redesigns the elements shown in Kuo as well as changes the basic principle under which Kuo was designed to operate, both of which are impermissible. *See MPEP §2143.01 V*. Specifically, Kuo discloses a base 1 having an orifice 12 extending through the side of the base 1. An elastic piece 2 is disposed between the base 1 and the orifice 12 such that changes in pressure through the orifice 12 moves the elastic piece 2. The rearrangement of components asserted by the Examiner on page 5 of the Office Action would require rearrangement of the orifice 12 to the “plunger portion 45 of DE 900544” as indicated by the Examiner on page 5 of the Office Action. Such a rearrangement would also require sizing a bore and the inner part 45 in the bore such that the inner part 45 would act as a component that can pull a vacuum, which is not taught, or even suggested, by Kuo or Koos. To the contrary, the inner part 45 pushes the lipstick with a positive force, as discussed above. Each of these rearrangements would substantially reconstruct and redesign the elements shown in Kuo as well as changes the basic principle under which Kuo was designed to operate. Because the combination substantially reconstructs and redesigns the elements shown in Kuo as well as changes the basic principle under which Kuo was designed to operate, the Applicant respectfully asserts that independent claims 1, 14, 17, 20, 29, and 31 are non-obvious over the combination of Kuo and Koos.

In any event, aside from the deficiencies in the obviousness rejection set forth above, the Applicant respectfully asserts that the combination and rearrangement set forth by the Examiner would not have been obvious to one of ordinary skill in the art before the invention was made. The Examiner must consider the claimed invention as a whole. Hindsight is impermissible and the legal conclusion of obviousness must be reached on the basis of the facts gleaned from the prior art. *See*

MPEP §2142. Because the combination of Kuo and Koos fails to teach each element of independent claims 1, 14, 17, 20, 29, and 31 and requires additional rearrangements and modifications not taught or suggested by either of those references, the Applicant respectfully asserts that the claimed invention would not have been obvious to one of ordinary skill in the art.

Provisional Non-Statutory Obviousness-Type Double Patenting

The Applicant notes the provisional rejection of claims 1, 2, 5-8, 14-15, and 17 and on the ground of non-statutory obviousness-type double patenting over claims 1, 2, 4-8, 10, and 12 of co-pending Application No. 11/578,082. The Applicant will address this rejection when the provisional rejection is the only rejection remaining in at least one of the present application and the '802 application. *See MPEP* §804.

In view of the foregoing, it is respectfully submitted that independent claims 1, 14, 17, 20, 29, and 31 and the claims that depend therefrom, are both novel and non-obvious over Kuo and Koos such that these claims are in condition for allowance, which allowance is respectfully requested. The Commissioner is authorized to charge our Deposit Account No. 08-2789 in the name of Howard & Howard Attorneys PLLC for any fees or credit the account for any overpayment for this matter.

Respectfully submitted,

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